REMARKS

New Claims 15-17 are added. New Claim 15 is supported by the specification, for example, at the paragraph spanning pages 6-7 and Figure 1. New Claims 16 and 17 are supported by the specification, for example, at page 2, first full paragraph, pages 6-7, Figure 1, and at page 18. Accordingly, new Claims 15-17 do not add new matter.

Upon entry of the amendments, Claims 8, 10-12 and 14-17 are pending. Applicants respectfully request entry of the amendments and reconsideration of the application in view of the following remarks.

Rejection Under 35 U.S.C. §102(b)

Claims 8, 10-12 and 14 are rejected under 35 U.S.C. §102(b) as being anticipated by Masuda (U.S. Publication No. 2002/0064650). The Office Action states that Masuda discloses all elements of the claims.

Applicants respectfully traverse.

Claim 8 is directed to a transparent surface protective film for transparent conductive substrates protecting a surface opposite to a side of a conductive thin film of the transparent conductive substrates or a surface on a side of the conductive thin film, comprising: a transparent base material film, a transparent adhesive layer formed on one side of the base material film, and a transparent antistatic layer formed on the other side of the base material film, said transparent surface protective film being configured to maintain transparency even after one-hour heat treatment at 150°C, wherein the antistatic layer comprises polymers having pyrrolidinium rings as multiple repeating units in main chains thereof. Claims 10-12 depend from Claim 14.

Claim 14 is directed to a transparent surface protective film for transparent conductive substrates protecting a surface opposite to a side of a conductive thin film of the transparent conductive substrates or a surface on a side of the conductive thin film, comprising: a transparent base material film, a transparent adhesive layer formed on one side of the base material film, and a transparent antistatic layer formed on the other side of the base material film, said transparent surface protective film being configured to maintain transparency even after one-hour heat treatment at 150°C, wherein the antistatic layer comprises polymers having pyrrolidinium rings

as multiple repeating units in main chains thereof, and wherein the entirety of the surface protective film is transparent.

Masuda

Masuda is directed to a biaxially oriented polyester film for window application. Masuda teaches that in the biaxially oriented polyester film for window application according to the Masuda's invention, it is essential that a dye be contained in at least one of the coextruded intermediate layers of the laminated film, and the dye used in the present invention needs to be one which shows absorption in the visible light region (380-780 nm). By containing such a dye, the visible light transmittance of the whole film is controlled to the range of 3 to 70%, preferably 5 to 50%. Thus, Masuda teaches that it is essential to reduce visible light transmittance to as low as 3%.

Masuda does not Disclose All Claim Elements

Claims 8 and 14 are directed to transparent surface protective films, where all layers of the film are transparent. Masuda, in contrast, teaches that it is essential to reduce visible light transmittance to as low as 3%. A film that reduces visible light transmittance to as low as 3% is not transparent. Accordingly, Masuda does not teach a transparent film. As such, Masuda does not teach all elements of Claims 8 and 14. Therefore, Claims 8 and 14 are novel over Masuda.

Rejection Under 35 U.S.C. §103

Claims 10 and 11 are rejected under 35 U.S.C. §102(b) as being anticipated by Masuda (U.S. Publication No. 2002/0064650). The Office Action states that it would have been obvious to modify the Masuda reference to arrive at the recited adhesive layer thicknesses.

Applicants respectfully traverse.

Claims 10 and 11 cannot be obvious over Masuda because Claim 8, from which Claims 10 and 11 depend, is not obvious over Masuda. As discussed above, Masuda, teaches that it is essential to reduce visible light transmittance to as low as 3%. A film that reduces visible light transmittance to as low as 3% is not transparent. Accordingly, Masuda does not teach a transparent film, and, in fact, teaches away from a transparent film. As such, it would not have been obvious for one of ordinary skill in the art to design a transparent surface protective film in

view of the teachings of Masuda. Accordingly ,Claim 8, and claims dependent therefrom, are not obvious over Masuda.

New Claims 15-17

New Claims 15-17 also are novel and non-obvious over Masuda.

New Claim 15 is directed to the transparent surface protective film of Claim 8, consisting of: the transparent base material film, the transparent adhesive layer formed on one side of the base material film, and the transparent antistatic layer formed on the other side of the base material film. Masuda does not anticipate or render obvious the transparent surface protective film of Claim 15 because Masuda teaches that it is essential to include an intermediate layer containing a dye. New Claim 15 recites no such intermediate layer containing a dye, and, thus, is novel over Masuda. It would have been non-obvious to exclude that which Masuda teaches is essential. Accordingly, new Claim 15 is non-obvious over Masuda.

New Claim 16 is also non-obvious over Masuda. New Claim 16 is directed to a method for protecting a transparent conductive substrate surface, comprising: providing a transparent surface protective film comprising a transparent pressure-sensitive adhesive layer on one side of a transparent base material film and a transparent antistatic layer on the other side of the transparent base material film, said transparent antistatic layer comprising polymers having pyrrolidinium rings as multiple repeating units in main chains thereof, and attaching said transparent surface protective film to a transparent conductive substrate which comprises a conductive thin film, wherein said transparent surface protective film is attached to a surface of the side of the transparent conductive substrate to which the conductive thin film is attached, or said transparent surface protective film is attached to an opposite side of the side of the transparent conductive substrate to which the conductive thin film is attached, wherein the transparent surface protective film maintains transparency after heat treatment at 150 °C. As discussed above in regard to Claim 8, Masuda does not teach a transparent film, and, thus, cannot render obvious a method of using a transparent film. Further, Masuda does not teach attaching a transparent surface protective film having the recited components to a transparent conductive film containing a conductive thin film. Masuda teaches applying a biaxially oriented polyester film to windows, not to transparent conductive films containing a conductive thin film. Masuda

provides no reason that would lead one of ordinary skill to attach a biaxially oriented polyester film to a transparent conductive film. In contrast, the Inventors of the present application have found that attaching a transparent surface protective film containing the recited components to a transparent conductive film yields the unexpectedly superior results of maintaining transparency even when exposed to high temperature for long time periods. Such properties would not be expected in view of the teachings of Masuda, and, thus, are evidence of the non-obviousness of Claim 16.

New Claim 17 is also non-obvious over Masuda. New Claim 17 is directed to the method of Claim 16, further comprising: heating to a temperature range of 90 °C to 150°C said transparent surface protective film attached to said transparent conductive substrate, wherein the transparent surface protective film maintains transparency throughout said heat treatment. Claim 17 is non-obvious for all of the reasons provided above in regard to Claim 16. In addition, Claim 17 is further novel and non-obvious over Masuda because nothing in Masuda would lead one of ordinary skill to perform a heat treatment a temperature range of 90 °C to 150°C on Masuda's polyester film when attached to a window. Masuda is directed to subject matter altogether different, and unrelated to methods that require heat treatment, and nothing in Masuda provides any indication of performing a heat treatment. Accordingly, new Claim 17 is non-obvious over Masuda.

CONCLUSION

In light of the Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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